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09/788,311	02/15/2001	Lawrence D. Hartsook	23712-05099	7055
758 7590 06/12/2008 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER				
DARNO, PATRICK A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/788,311

Applicant(s)

HARTSOOK ET AL.

Examiner

PATRICK A. DARNO

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 14, and 17-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9, 11-12, 14, and 17-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Claim 30 is new. Claims 10, 13, and 15-16 are cancelled. Claims 1, 19, and 24 are amended. Claims 1-9, 11-12, 14, 17-30 are pending in this office action.

Specification Objections

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Specifically, it appears that the specification fails provide proper antecedent basis for the phrase "computer program product" as recited in claims 19-23. Correction of this deficiency is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-28 are rejected under 35 U.S.C. 101 because the claimed invention appears to be directed to non-statutory subject matter.

With respect to claim 19, the claim is rejected because it does not appear to be limited to physical articles or objects. As the claim is currently presented, it is reasonable to interpret a "computer program product" as comprising mediums which are not statutory under 35 U.S.C. 101 such as carrier waves, propagation mediums, or even a piece of paper with software code written on it. Since the claimed computer readable medium can be reasonably interpreted to comprise mediums which are not statutory under 35 U.S.C. 101, the claims remain rejected under 35 U.S.C. 101 as being directed simply software. This rejection will be maintained until the objection to the specification is resolved above.

Claims 20-23 are rejected because they either inherit or contain the deficiencies of claim 19.

With respect to claim 24, the claim recites a system. However, it appears that the system of claim 24 is not limited to physical articles or objects. From referencing the Applicant's specification page 6, line 19 - page 7, line 2 it appears that all claimed modules can be interpreted as only software modules. Since the claimed "identification module", "data access module", and "rendering module" all appear to be directed to software subroutines, it appears that the Applicant may be seeking to patent the particular programmed functionality of the modules, rather than a physical combination of the hardware and software which permits the programmed functionality to be realized.

In order to overcome this rejection, the Applicant must amend claim 24 such that there is some recitation of computer hardware which would then ensure that claim 24 is limited to an apparatus or system comprising a combination of hardware and software as opposed to a system comprising only software modules. Doing so ensures that the claimed invention is strictly limited to a physical article or object, and therefore satisfies the requirements of 35 U.S.C. 101.

Claims 25-28 are rejected because they either contain or inherit the deficiencies of claim 24.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, 11-12, and 17-30 are rejected under 35 U.S.C. 102(c) as being anticipated
U.S. Patent Application Publication Number 2007/0016909 issued to Taylor S. Gautier
(hereinafter "Gautier").

Claim 1:

Gautier discloses a computer implemented method dynamically rendering data in a markup language (*Gautier: paragraph [0028] and paragraph [0031], lines 7-9 and paragraph [0032], lines 2-10 and paragraph [0010], lines 13-17 and paragraph [0017], lines 5-8 and claim 2*), the method comprising:

identifying a symbol in the data in the markup language (*Gautier: paragraph [0046], lines 1-6 and paragraph [0029], lines 1-5 and Fig. 3a; Note that the "OPT" symbol is identified in the data in the markup language.*), the symbol indicating a query of a data set (*Gautier: paragraph [0030], lines 14-17 and paragraph [0009], lines 4-8; Note that the data within the OPT tags is "variable data selected from the database 100 in response to a query."*), the query containing one or more variables, each variable of one of a plurality of data types (*Gautier: paragraph [0030], lines 14-22 and Fig. 3a; Note that the query appears to have included variables for at least retrieving turning instructions (Turn Left, L), distance information (.2 miles or .2 m), and time information (.9 minutes or .9m).*);

augmenting the markup language to support the variables (*Gautier: paragraph [0009], lines 1-4*), by building a variable resolution functionality into the markup language, each variable resolving to two or more variable values (*Gautier: paragraph [0029], lines 1-6 and paragraph [0009], lines 1-4 and Fig. 3a*);

accessing the data set in order to generate a resolution to the query, wherein the one or more variables contained in the query are resolved as part of the generation of the resolution to

the query (*Gautier: paragraph [0032], lines 2-10 and paragraph [0017]*), the query associated with a tag in the markup language (*Gautier: paragraph [0030], lines 14-17*);

substituting the two or more variable values for each variable into query to generate two or more completed queries (*Gautier: Fig. 3a and paragraph [0030], lines 14-22; Note that the variables “Turn Left” & “L” and “minutes” and “min” are returned to complete the two queries issued to fill the “OPT” tags.*); and

dynamically rendering the resolution to the two or more completed queries as a part of the markup language (*Gautier: paragraph [0009] and paragraph [0029] and paragraph [0010], lines 13-17 and Fig. 3a*), according to at least one rule associated with the markup language wherein said symbol can be used to dynamically render multiple data sets (*Gautier: paragraph [0012], lines 1-4 and paragraph [0032]*).

Claim 2:

Gautier discloses all the elements of claim 1, as noted above, and Gautier further discloses wherein the symbol comprises a delimited token (*Gautier: paragraph [0013] and paragraph [0029]*).

Claim 3:

Gautier discloses all the elements of claim 1, as noted above, and Gautier further discloses wherein the symbol is located within the data in the markup language such that the query is associated with the markup language (*Gautier: paragraph [0029] and paragraph [0030], lines 14-22 and paragraph [0032] and Fig. 3a*).

Claim 4:

Gautier discloses all the elements of claim 3, as noted above, and Gautier further discloses wherein the markup language comprises Hyper Text Markup Language (*Gautier: paragraph [0028]*).

Claim 5:

Gautier discloses all the elements of claim 3, as noted above, and Gautier further discloses rendering the resolution according to at least one rule associated with the markup language tag with which the query is associated (*Gautier: paragraph [0012], lines 1-4 and paragraph [0032]*).

Claim 6:

Gautier discloses all the elements of claim 1, as noted above, and Gautier further discloses wherein the dataset comprises a set of at least one document in a hierarchically structured format (*Gautier: paragraph [0028] and Fig. 3a*).

Claim 7:

Gautier discloses all the elements of claim 6, as noted above, and Gautier further discloses wherein the hierarchically structured format comprises Extensible Markup Language (*Gautier: paragraph [0028] and Fig. 3a*).

Claim 8:

Gautier discloses all the elements of claim 7, as noted above, and Gautier further discloses wherein the symbol conforms an Extensible Markup Language standard concerning queries (*Gautier: paragraphs [0028]-[0029] and paragraph [0030], lines 14-22*).

Claim 9:

Gautier discloses all the elements of claim 1, as noted above, and Gautier further discloses wherein the data set comprises a database (*Gautier: paragraph [0030], lines 14-22 and Fig. 3a*).

Claim 11:

Gautier discloses all the elements of claim 1, as noted above, and Gautier further discloses wherein the rendering is performed by software running on a hand held computing device (*Gautier: Fig. 1, element 106 and paragraph [0031] and claim 2*).

Claim 12:

Gautier discloses all the elements of claim 1, as noted above, and Gautier further discloses generating a resolution to the query by retrieving a node set from a set of documents in Extensible Markup Language; and rendering each member of the node set (*Gautier: Figs. 3a, 3b, and 3c*).

Claim 17:

Gautier discloses all the elements of claim 1 as noted above, and Gautier further discloses wherein rendering the resolution further comprises updating the data set (*Gautier: paragraph [0030], lines 14-22; The data sets within the OPT tags are updated in response to the query of the database.*).

Claim 18:

Gautier discloses all the elements of claim 17, as noted above, and Gautier further discloses wherein updating the data set further comprises writing to a set of at least one document in Extensible Markup Language (*Gautier: paragraph [0030], lines 14-22 and Fig. 3a; The query retrieves the variables to fill the OPT tags and then the variables are written into the OPT tags as shown in Fig. 3a.*).

Claim 19:

Claim 19 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 20:

Claim 20 is rejected under the same reasons set forth in the rejection of claim 5.

Claim 21:

Claim 21 is rejected under the same reasons set forth in the rejection of claim 12.

Claim 22:

Claim 22 is rejected under the same reasons set forth in the rejection of claim 17.

Claim 23:

Claim 23 is rejected under the same reasons set forth in the rejection of claim 18.

Claim 24:

Claim 24 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 25:

Claim 25 is rejected under the same reasons set forth in the rejection of claim 5.

Claim 26:

Claim 26 is rejected under the same reasons set forth in the rejection of claim 12.

Claim 27:

Claim 27 is rejected under the same reasons set forth in the rejection of claim 17.

Claim 28:

Claim 28 is rejected under the same reasons set forth in the rejection of claim 18.

Claim 29:

Gautier discloses all the elements of claim 3, as noted above, and Gautier further discloses wherein the markup language comprises Wireless Markup Language (*Gautier: paragraphs [0028] and [0031]; The invention discloses markup languages for use on a wireless portable device. Surely this would comprise a wireless markup language.*).

Claim 30:

Gautier discloses all the elements of claim 1, as noted above, and Gautier wherein augmenting the markup language to support the variables further comprises:

providing a variable table for storing names and values of the variables, each variable of one of the plurality of data types (*Gautier: Fig. 3c; This figure appears to show at least a two column table storing variable data. The variables that are stored in this table are listed in the OPT tags in Fig. 3a.*); and

utilizing a syntax in the markup language for creating the variables by adding the variables to the variable table (*Gautier: Fig. 3a and Fig. 3c; The mark-up language syntax disclosed in Fig. 3a is used to generate the table of Fig. 3c.*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gautier, and further in view of U.S. Patent Application Publication Number 2002/0198874 issued to Roger I. Nasr et al. (hereinafter "Nasr").

Claim 14:

Gautier discloses all the elements of claim 1 as noted above, but Gautier does not explicitly disclose wherein each variable contained in the query comprises a delimited token.

However, Nasr discloses wherein each variable contained in the query comprises a delimited token (*Nasr: paragraphs [0100] - [0104]; <MYDOC> appears to be a delimiting token in the query shown.*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Gautier with the teachings of Nasr noted above. The skilled artisan would have been motivated to improve the teachings of Gautier per the above in order to allow a Web site user to have control of the content through their queries (*Nasr: paragraph [0107]*).

Response to Arguments

Examiner Notes:

The Applicant's arguments are moot in light of new grounds of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung T Vy/
Primary Examiner, Art Unit 2163

/Patrick A. Darno/
Examiner
Art Unit 2163
06-08-2008

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